

REMARKS

The Official Action mailed February 7, 2005, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicants respectfully submit that this response is being timely filed.

The Applicants note with appreciation the consideration of the Information Disclosure Statement filed on December 13, 2004.

Claims 43-123 are pending in the present application. Prior to the above amendment, claims 43, 44, 47, 48, 73-75, 82-84 and 94-97 were independent. Claims 43, 44, 47, 48, 53-75, 82-84 and 94-123 have been amended to better recite the features of the present invention. The Applicants note with appreciation the allowance of claims 47-52, 82-93, 96, 97 and 100-103 (page 10, Paper No. 01192005). Claims 53-56 and 104-107 have been amended into independent form and incorporate the features of claims 43, 44, 47, 48 and 94-97, respectively. Since claims 47, 48, 96 and 97 have been allowed, claims 55, 56, 106 and 107 are now believed to be in condition for allowance.

Accordingly, claims 43-123 are now pending in the present application, of which claims 43, 44, 47, 48, 53-56, 73-75, 82-84, 94-97 and 104-107 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action objects to claims 55, 56, 59, 60, 63, 64, 67, 68, 71, 72, 106, 107, 110, 111, 114, 115, 118, 119, 122 and 123 under 37 CFR 1.75(c) asserting that the claims fail to further limit the subject matter of a previous claim. The Official Action asserts that claims 55, 56, 106 and 107 are product-by-process claims and suggests that the claims could be rewritten in independent form to overcome the objection. It is noted that the preambles of claims 53, 54, 104 and 105 are similar to claims 55, 56, 106 and 107. In response and in accordance with the suggestion in the Official Action, claims 53-56 and 104-107 have been rewritten in independent form. Also, claims 57-72

and 108-123 have been amended to positively recite a method step, claims 57-72 have been amended to depend from claims 43, 44, 47 and 48, and claims 108-123 have been amended to depend from claims 94-97. Reconsideration and withdrawal of the objections are requested.

The Official Action rejects claims 43-46, 53, 54, 57, 58, 61, 62, 65, 66, 69, 70, 73-81, 94, 95, 98, 99, 104, 105, 108, 109, 112, 113, 116, 117, 120 and 121 as obvious based on the combination of U.S. Patent No. 6,632,711 to Sugano et al. and U.S. Patent No. 6,518,962 to Kimura et al., either alone or in combination with one or more of U.S. Patent No. 6,274,887 to Yamazaki et al., U.S. Patent No. 5,760,855 to Nakase et al., or U.S. Patent No. 6,729,922 to Hiroki. Specifically, independent claims 43, 44, 73, 94 and 95 are rejected based on the combination of Sugano and Kimura (pages 3-5, Paper No. 01192005); and independent claims 74 and 75 are rejected based on the combination of Sugano, Kimura and Nakase (pages 6-8, *Id.*). Regarding independent claims 43, 44, 53, 54, 94, 95, 104 and 105, the Applicants respectfully submit that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended. Regarding independent claims 73-75, the Applicants respectfully traverse the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in

the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims. For the reasons provided below, Sugano, Kimura, Yamazaki, Nakase and Hiroki, either alone or in combination, do not teach or suggest at least the above-referenced features of the present invention.

Independent claims 43, 44, 53 and 54 have been amended to recite forming a plurality of pixel electrodes by patterning a conductive film after a judging. Sugano and Kimura do not teach or suggest at least the above-referenced features of the present invention.

Independent claims 73-75 recite that a thin film transistor is made in an on state before forming a pixel electrode by patterning a conductive film. With respect to claim 73, the Official Action asserts that Sugano teaches "making the plurality of thin film transistors (1) in an on state; and forming a plurality of pixel electrodes (11) by patterning the conductive film ... (col. 16, lines 63-64)" (page 4, Paper No. 01192005). It also appears that the Official Action relies on column 15, line 36, to column 16, lines 19, and column 16, line 47-60, to support the teaching of a plurality of thin film transistors (1). However, Sugano does not appear to teach or suggest that a thin film transistor is made in an on state or that this is done before forming a pixel electrode by patterning a conductive film. Similarly, with respect to claims 74 and 75, the Official asserts that Nakase teaches "making the plurality of thin film transistors (5) in an on state; and forming a plurality of pixel electrodes ... (col. 5, line 64 thru col. 6, line 5)" (page 7, Id.). However, like Sugano, Nakase does not appear to teach or suggest that a

thin film transistor is made in an on state or that this is done before forming a pixel electrode by patterning a conductive film.

Independent claims 94, 95, 104 and 105 have been amended to recite making first and second thin film transistors in an on state; measuring a value of electric current flowing in a measurement wiring, and judging whether or not the first and said second thin film transistors are defective from the value; and forming first and second pixel electrodes by patterning a conductive film to be electrically connected to the first and second thin film transistors, respectively. As noted above, Sugano does not appear to teach or suggest that a thin film transistor is made in an on state. Also, the Applicants respectfully submit that Sugano does not teach or suggest forming first and second pixel electrodes by patterning a conductive film to be electrically connected to the first and second thin film transistors, respectively. The Official asserts that Kimura teaches "making the plurality of thin film transistors (221, 223) in an on state, measuring a value of electric current flowing in the measurement wiring, and judging whether or not the plurality of thin film transistors (221, 223) are defective from the value (col. 6, lines 33-49); and forming a plurality of pixel electrodes (10) ... (col. 20, lines 25-40)" (pages 4-5, Id.). However, Kimura does not appear to teach or suggest that first and second thin film transistors are made in an on state. Also, column 6, lines 33-49, appear to teach seventh and eighth embodiments of the Kimura device (referred to as "one form" and "another form" in Kimura). It is unclear whether the Official Action relies on one or both of these embodiments to teach the features of the present invention. It is also unclear how or why one or both of these embodiments are to be combined with the embodiment disclosed at column 20, lines 25-40, which is relied upon to teach thin film transistors 221, 223. The Applicants respectfully submit that it would not have been obvious to combine one or both of these embodiments disclosed at column 6, lines 33-49 of Kimura with the embodiment disclosed at column 20, lines 25-40 of Kimura, and to also incorporate this alleged combination with Sugano. Therefore, Sugano and Kimura, either alone or in combination, do not appear to teach or suggest making first and

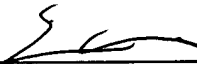
second thin film transistors in an on state; measuring a value of electric current flowing in a measurement wiring, and judging whether or not the first and said second thin film transistors are defective from the value; and forming first and second pixel electrodes by patterning a conductive film to be electrically connected to the first and second thin film transistors, respectively.

Yamazaki (pages 5-6 and 9-10) and Hiroki (pages 8-9) are relied upon to allegedly teach features of the dependent claims of the present invention and do not cure the above-referenced deficiencies in Sugano, Nakase and Kimura.

Since Sugano, Kimura, Yamazaki, Nakase and Hiroki do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Eric J. Robinson
Reg. No. 38,285

Robinson Intellectual Property Law Office, P.C.
PMB 955
21010 Southbank Street
Potomac Falls, Virginia 20165
(571) 434-6789